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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------------|
| 09/715,874 | 11/17/2000 | Carl M. Sullivan | 30222/20:100 | 7638 |
| 23446 7590 05/17/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661 | | | EXAMINER FERGUSON, LAWRENCE D | |
| | | | ART UNIT 1774 | PAPER NUMBER |
| | | | MAIL DATE 05/17/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--|--|
| Office Action Summary | Application No. 09/715,874 | Applicant(s) SULLIVAN ET AL. | |
| | Examiner Lawrence D. Ferguson | Art Unit 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-11,18,19,21-23,25-29 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5, 8-11, 18-19, 21-23, 25-29 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 23, 2007.

Claims 1, 18, 22 and 31 were amended, claim 30 was cancelled and claims 34-36 were added rendering claims 1-2, 4-5, 8-11, 18-19, 21-23, 25-29 and 31-36 pending.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 34-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 34, the phrase, 'plasticizer is at least one of epoxidized soya bean oil or di(2-ethyl-hexyl) adipate in an amount at least about 22 pph' is not supported by the specification. Additionally, in claim 35, the phrase, 'di(2-ethyl-hexyl) adipate is present in an amount at least about 21.6 pph' is not supported by the specification. The Examiner was not able to find support for the added limitation discussed above at the cited portions of the specification.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5, 8-11, 22-23, 25-27, 29 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenlee (U.S. 5,248,546).

Greenlee discloses a multilayered article comprising a first layer of polyvinyl chloride and a second layer of polyvinyl chloride, which are adjacent to each other (column 2, lines 17-45) where the PVC compounds contain plasticizers (column 5, lines 8-14). Greenlee discloses the PVC containing layers comprise antistatic agents having levels less than 20phr (column 6, lines 44-55) which is a surface reactive agent. The reference discloses the epoxidized soybean oil plasticizer (second plasticizer) ranges from 0.5 to 10 phr (column 5, lines 56-65) and a polyester plasticizer such as adipates, where at least one optional plasticizer may be included in any layer (column 5, lines 66-67, column 6, lines 27-28 and column 15, lines 1-5). Greenlee discloses along with the addition of plasticizers, copolymers can be incorporated in the layers as well (column 6, lines 20-26) such as polyester adipates (column 14, line 56 through column 15, line 5). The reference discloses the second layer is at least three degrees Celsius higher than the heat distortion temperature (melting point) of the first layer (column 2, lines 36-40).

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In claim 22, the phrase, "degree of stiffness suitable for wrapping foods and an oxygen transmission rate suitable for wrapping foods" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Because Greenlee teaches an article comprising two layers of polyvinyl chloride and epoxidized soya bean oil plasticizer, where the two layers have different melting points, it is expected for one of the layers to seal to itself when heat is transferred through the other layer, for the two layers to have different gas permeabilities and for the film to be visually clear. Greenlee does not explicitly disclose the thickness of the film or amount of plasticizer. Although Greenlee does not specifically disclose the thickness of the film or amount of plasticizer, thickness and amount of plasticizer are optimizable features. It would have been obvious to one of ordinary skill in the art to optimize the film because discovering an optimum or workable range involves only routine skill in the art. The thickness and plasticizer amount directly affect the durability of the film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

In all of the above mentioned claims, the instant invention includes the preamble language of, "a flexible packaging film". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble

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merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, the preamble language has not been accorded patentable weight.

Claim Rejections – 35 USC § 103(a)

6. Claims 18-19, 21, 28 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon et al (U.S. 3,650,775).

Simon discloses a packaging film (column 1, lines 4-5) which is clearly transparent (column 2, lines 15-17) having top and bottom polyvinyl chloride copolymer plies, which are non-fogging and have slip additives (surface active agent) (column 3, lines 3-15). The packaging films are flexible (column 9, lines 72-75 and column 10, lines 36-55) and comprises polyvinyl chloride films having plasticizers such as di(2 ethyl hexyl) adipate and epoxidized soya bean oil (column 4, lines 4-9). In claim 18, the phrase, "degree of stiffness suitable for wrapping foods and an oxygen transmission rate suitable for wrapping foods" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Simon does not explicitly disclose the thickness of the film. Although Simon does not specifically disclose the thickness of the film, plasticizer amount or ratio of the plasticizer material, thickness, amount of plasticizer and ratio of materials are optimizable features. It would have been obvious to one of ordinary skill in the art to optimize the film because discovering an optimum or workable range involves only routine skill in the art. The thickness, amount of plasticizer

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and ratio of plasticizer material directly affects the durability and flexibility of the film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

Response to Arguments

7. Rejection made under 35 U.S.C. 102(b) as being anticipated by Greenlee (U.S. 5,248,546) is withdrawn due to amendments made by Applicant; however, Greenlee is maintained under 35 U.S.C. 103(a). Applicant argues the Greenlee reference does not teach a flexible packaging film, but discloses a composition that is rigid.

The instant invention includes the preamble language of, "a flexible packaging film". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, the preamble language has not been accorded patentable weight. Additionally, the term flexible in the preamble does not clearly or patentably distinguish over the cited prior art as most materials have a certain degree of flexibility. Applicant further argues the composition of Greenlee is intended for a refrigerator door liner which requires a rigid compound.

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A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant's arguments made regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Simon et al (U.S. 3,650,775) have been considered but are unpersuasive. Applicant argues the Simon reference does not disclose at least two layers that are adjacent to one another. Examiner respectfully disagrees because Simon discloses flexible packaging films that are superimposed (adjacent) upon one another (column 10, lines 36-40 and 49-55 and Figure 1). Examiner acknowledges there is an opening in the packaging film of Simon; however, the packaging film of Simon remains adjacent to one another. In column 2, lines 58-63, Simon teaches the packaging film may be used to package meat and may be opened by blasting air into the package, which means the packaging film is capable of packaging meat through an opening in the package. Although the package of Simon is capable of packaging meat, the disclosure meets the limitation of a flexible packaging film have two layers, which are adjacent to one another.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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